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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,121	06/15/2001	Pierre N. Fay	404-193.016-1	8258

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EXAMINER
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SANDERS JR, JOHN R

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/883,121

Applicant(s)

FAY ET AL.

Examiner

John R. Sanders

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 September 2004 has been entered.

### *Response to Arguments*

2. The declaration filed on 2 January 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Foley '223 reference.

3. Applicant has argued that since the co-inventor Michael P. Shanley cannot be reached after diligent effort, the remaining inventor can sign the declaration on behalf of both parties. 37 CFR 1.131 states that a person qualified under 37 CFR 1.47 may sign, and *as directed to the matter of the signing of an effective declaration*, this is true. 37 CFR 1.131(a) states "the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based." In this case, the declaration submitted by Applicant is properly signed but fails to provide evidence that establishes invention of the subject matter prior to Foley '223.

Art Unit: 3737

4. Applicant has argued that 37 CFR 1.131(b) states that "absence of original exhibits need not be included if their absence is satisfactorily explained." This paraphrasing of 37 CFR 1.131(b) is misleading as it appears that, as long as the Applicant can explain the absence of original exhibits or records of facts, they are not required by the declaration.

5. 37 CFR 1.131(b) states:

"The showing of facts shall be such, in **character and weight**, as to **establish reduction to practice** prior to the effective date of the reference, or **conception of the invention** prior to the effective date of the reference coupled with **due diligence** from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, **must** accompany and form part of the affidavit or declaration or their absence satisfactorily explained." (Emphasis added.)

6. The statute states that evidence must be shown in the declaration to establish the conception of the invention. A confirmed statement that such evidence was, for example, destroyed in a fire would be satisfactory explanation of the absence of the evidence, since the evidence no longer exists. In this case, the evidence is the possession of one inventor who, for some reason, is unavailable to both the co-inventor and the inventor's counsel. This is not deemed a satisfactory explanation of the absence of evidence to swear behind the Foley '223 reference.

#### *Claim Rejections - 35 USC § 103*

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. **Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,095,650 to *Gao et al.* in view of U.S. Patent No. 6,535,223 to *Foley*.**

9. *Gao* discloses an interactive eyewear selection system (FIG. 1) including an imaging device (18) for capturing an image of a customer's face, a display screen (26) for both product selection and displaying a composite image, information receiving means (28, 30), and an image generating means (38) for superimposing the image of the customer's face with that of a trial frame (col. 6: 14-23). *Gao* discloses determining facial parameters such as pupil centers, intraocular distances and face edges (col. 8: 5-10) and using these parameters to scale the frame image to the face image (col. 10: 29-37). *Gao* discloses determining facial parameters in a location remote from the location of the eyewear via the Internet (col. 10, 19-22).

10. *Gao* does not disclose expressly using the invariant diameter of the iris as a reference for determining the size of a facial feature of the customer, nor does *Gao* disclose expressly counting the number of pixels to measure the iris and facial features.

11. *Foley* discloses the iris diameter as a reference object (abstract; col. 2: 43-45). *Foley* also discloses measuring the number of pixels across the reference object (abstract; col. 2: 60-65). *Gao* and *Foley* are analogous art because they both deal with the problem of determining size and scale factors concerning facial features and digital photographs.

12. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the iris as a reference object and to make measurements of digital images using pixel units. The suggestion/motivation for doing so would have been due to the fact that, (a) the iris is of substantially constant diameter from person to person, and (b) pixel measurements are commonly made in digital imaging when distance in an image is unknown; using different units

Art Unit: 3737

in a scale ratio does not alter the value of the ratio. Therefore, it would have been obvious to combine *Foley* with *Gao* to obtain the invention as specified in claims 1-17.

13. Regarding the amendment to claim 2, the Examiner reasserts that it is common knowledge that a circle viewed at an angle will appear as an ellipse and that the major axis of the ellipse will have the same length as the diameter of the circle. Therefore, it would have been obvious to one of ordinary skill in the art to include the previously rejected limitations of claim 8 in claim 2.

### *Conclusion*

14. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

Art Unit: 3737

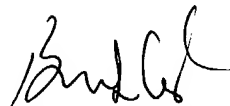
1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Sanders whose telephone number is (703) 305-4974. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on (703) 308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
jrs

  
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